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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,544	06/29/2001	Barry J. Robson	01-1236	6551

8840 7590 05/20/2004

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EXAMINER	
JOHNSON, EDWARD M	

ART UNIT	PAPER NUMBER
1754	

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/895,544	ROBSON ET AL.	
	Examiner	Art Unit	
	Edward M. Johnson	1754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 December 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31 and 33-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-20,22,24-31,33-39 and 41* is/are rejected.

7)☒ Claim(s) *6,21,23,40 and 42* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Australia on 3/01/01 and 3/28/00. It is noted, however, that applicant has not filed certified copies of the Australian applications as required by 35 U.S.C. 119(b).

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Australia on 3/28/00. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter.

Specification

3. The amendment filed 12/23/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The particular claimed range was not described in the original disclosure. Rather, specific examples were given at certain points of the range, including the endpoints.

Applicant is required to cancel the new matter in the reply to this Office Action.***Claim Objections***

4. Claims 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must recite the claims it depends from in the alternative. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-31 and 33-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The particular claimed range was not described in the original disclosure. Rather, specific examples were given at certain points of the range, including the endpoints.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 25-28 depend from a canceled claim.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-2, 4-5, 7-8, 10-13, 16-19, 24-31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al. US 5,858,325.

Regarding claim 1, Hall '325 discloses a method for agglomeration of alumina material comprising forming a mixture of pseudo-boehmite and alumina (see column 7, lines 37-43) and spray drying to produce agglomerated granules (see column 7, lines 45-50 and 54-60), wherein the amount of alumina added is

present in an amount of at least about 5% (see column 4, lines 10-14).

Regarding claims 2, 4-5, and 29 Hall '325 discloses forming an aqueous slurry (see column 6, lines 1-14) and subjecting to spray drying at 1200 degrees Celsius (see column 3, line 50).

Regarding claims 7-8, Hall '325 discloses a pH of about 3-10 (see column 2, lines 43-45) using HCl (see column 3, lines 9-10).

Regarding claims 10-12 and 33, Hall '325 discloses 3 and 7 micron alumina (see column 4, lines 55-67).

Regarding claims 13 and 16, Hall '325 discloses an aqueous slurry (see Example 1).

Regarding claims 17-19, Hall '325 discloses solids content of 48-56% (see column 3, lines 13-16) determining slurry viscosity.

Regarding claims 24, Hall '325 discloses purifying and calcining.

Regarding claims 25-28, Hall '325 discloses filtering and neutralizing (see column 1, lines 17-18 and column 2, lines 43-47).

Regarding claims 30-31, Hall '325 discloses heating up to 1200 degrees Celsius, which would at require reaching and passing 300 degrees Celsius.

11. Claim 34 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hall '325.

Regarding claim 34, Hall '325 discloses a method for agglomeration of alumina material comprising forming a mixture of pseudo-boehmite and alumina (see column 7, lines 37-43) and spray drying to produce agglomerated granules (see column 7, lines 45-50 and 54-60), wherein the amount of alumina added is present in an amount of at least about 5% (see column 4, lines 10-14).

In the event any differences can be shown for the product of the product-by-process claim 34, as opposed to the product taught by Hall '325, such differences would have been obvious to one of ordinary skill in the art at the time the invention was made as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed.Cir. 1985).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

> the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 3, 9, 14-15, 20, 22, 35-39, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall '325.

Regarding claim 3, Hall '325 fails to specifically disclose the suspension at 15-100 degrees C.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the suspension at room temperature because Hall subsequently discloses spray drying at a high temperature, which would obviously, to one of ordinary skill, suggest forming the suspension with no temperature control, which would lead to an ambient or room temperature falling within the claimed range.

Regarding claims 9, 20, 22, 39, and 41, Hall '325 fails to disclose acetic acid.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to control the pH with acetic acid because Hall '325 discloses "other suitable acids", specifically mentioning formic and oxalic acid, which would obviously, to one of ordinary skill, at least suggest other common acids outside the disclosed range with similar chemical formulas including acetic acid.

Regarding claim 14, Hall '325 fails to disclose grinding.

It is considered that it would have been obvious to one of ordinary skill in the art at the time the invention was made to subject the alumina to grinding because Hall '325 discloses the alumina in "powder" form and attrition (see Example 1 and Table 3), which would obviously, to one of ordinary skill, at least suggest grinding to form the disclosed fine "powder".

Regarding claims 15 and 35-38, Hall '325 discloses an aqueous slurry with a solids content of 48-56% (see column 3, lines 13-16).

Allowable Subject Matter

14. Claims 21, 23, 40, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter: It would not have been obvious to one of ordinary skill in the art at the time the invention was made to set a slurry viscosity of less than 4 cp in the process of the instant claims 21 and 40 nor set the concentration of acetic acid in the slurry to 0.2-1.5% in the process of the instant claims 23 and 42.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward M. Johnson whose telephone number is 571-272-1352. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley S. Silverman can be reached on 571-272-1358. The fax phone numbers for the

organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.

EMJ
May 16, 2004

ST[illegible]ERMAN
SUPERVI[illegible]T EXAMINER
TECHNOLOGY CENTER 1700